

REMARKS

STATUS OF THE CLAIMS

Claims 1-258 remain pending in the application. Claims 28-73, 99-178, and 199-238 have been withdrawn from consideration by the Examiner. Of the claims that were examined (i.e., claims 1-27, 74-98, 179-198, and 239-258), claims 1 and 74 are independent.

In the Office Action, claims 1-6, 8, 10-27¹, 74-81, 83-98, 179-186, 189, 190, 192, 194-198, 239-247, 249, 250, 252, and 254-258 were rejected under 35 U.S.C. § 102(e) as being anticipated by Marapane et al. (U.S. Patent Application No. 2002/0010556; hereinafter "Marapane"). In addition, claims 7, 9, 82, 187, 188, 247, 248, 191, 193, 251, and 253 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marapane.

REJECTION UNDER SECTION 102(e)

Applicant respectfully submits that the rejection of claims 1-6, 8, 10-16, 19-27, 74-81, 83-98, 179-186, 189, 190, 192, 194-198, 239-247, 249, 250, 252, and 254-258 under 35 U.S.C. § 102(e) as being anticipated by Marapane should be withdrawn because Marapane does not disclose all the recitations of independent claims 1 and 74.

Independent Claim 1

With regard to independent claim 1, Marapane does not disclose a method for providing hair tinting information including, among other things, "providing information relating to a plurality of hair tinting products" or "receiving third information

¹ Applicant notes that once again claim 17 was listed in the § 102(e) rejection statement and not in the § 103(a) rejection statement, yet was discussed only in the § 103(a) rejection. Therefore, for purposes of this response, Applicant will once again consider claim 17 and claim 18, which depends therefrom, to have been rejected under § 103(a).

representative of the subject's selection of at least one hair tinting product in the plurality of hair tinting products," as recited in claim 1. (Emphasis added). Rather, Marapane discloses identifying and displaying "achievable end colors from which the recipient will be prompted to select." Page 4, paragraph [0045]; see also Fig. 1, block 180; emphasis added. Further, Marapane discloses prompting a recipient to select from the displayed achievable end colors (paragraphs [0032] and [0045]; block 190), and recommending to the consumer a hair coloring agent based on the consumer's selection at 190 (paragraph [0032]; block 200). Therefore, Marapane fails to disclose all of the recitations of claim 1 at least because Marapane discloses displaying a plurality of colors from which to choose rather than "providing information relating to a plurality of tinting products" from which to choose, as recited in claim 1.

Only after a consumer has selected a desired end hair color (step 190) does Marapane provide any information about a product. (See Fig. 12.) However, Marapane appears to only provide information about a single product (that achieves the selected desired end hair color). Id. Thus, Marapane does not provide "information about a plurality of hair tinting products," as recited in claim 1. (Emphasis supplied). For at least this reason, the § 102(e) rejection of claim 1 should be withdrawn.

In the "Response to Arguments" section, the final Office Action asserts that "it is . . . old and well known that there are [sic] more than one method of dying a recipient's hair color to achieve an end result." Final Office Action at 12. However, regardless of whether this assertion is true, Marapane does not disclose "providing information relating to a plurality of hair tinting products," as recited in claim 1 and, therefore, the rejection of claim 1 under 35 U.S.C. § 102(e) is improper.

Independent Claim 74

With regard to claim 74, Applicant has amended claim 74 to read as follows:

74. A method for providing hair tinting information, comprising successively:

- receiving first information representative of at least one state of a subject's hair;
- providing, based on at least the first information, at least one type of color result prior to receiving information representative of a desired type of color result of a subject;
- receiving second information representative of a desired type of color result of the subject; and
- providing, based on at least the first information and the second information, information relating to at least one hair tinting product.

(Emphasis added.) Marapane does not teach these successive features.

In the final Office Action, the Examiner appears to be attempting to equate the four clauses in the body of claim 74 with steps 160, 180, 190, and 200 of Marapane as follows: clause 1 ("receiving ...") -- step 160, clause 2 ("providing ...") -- step 180, clause 3 ("receiving...") -- step 190, and clause 4 ("providing...") -- step 200.

Applicant's claim 74, as amended, now irrefutably specifies that the recited "providing, based on at least the first information [representative of at least one state of a subject's hair], at least one type of color result" occurs "prior to receiving information representative of a desired type of color result." (Emphasis supplied.)

In contrast, Marapane discloses receiving a family color selection (which the Examiner appears to equate with information representative of a desired type of color result) at step 170 PRIOR to providing at least one type of color result in Step 180. Therefore, Marapane does not disclose "providing, based on at least the first

information [representative of at least one state of a subject's hair], at least one type of color result prior to receiving information representative of a desired type of color result," as recited in independent claim 74.

In other words, at least one way in which the method recited in claim 74 distinguishes over the method taught by Marapane is that, in the presently claimed method, the display of available colors is not based on any information received from the user regarding end color selection. That is, the method of claim 74 provides one or more types of color results based on received information representative of state(s) of a subject's hair, whereas Marapane discloses limiting the display of available colors to only those colors within a selected color family (via Marapane's step 170). Thus, Applicant respectfully submits that claim 74 distinguishes over Marapane because Marapane discloses acquisition of information regarding a color family selection in step 170 prior to the display of achievable end colors in step 180.

Although Marapane discloses displaying hair color families at step 170 prior to the family color selection in step 170 or the desired color selection at step 190, Marapane does not disclose that the displaying of hair color families is based on "information representative of at least one state of a subject's hair," as recited in claim 74. Only the end hair colors displayed by Marapane in step 180 are disclosed as being "achievable" and based on input in block 160. Paragraph [0032]. Therefore, it appears that at step 170 Marapane displays all hair color families in the system and does not base the display of hair colors on the subject's natural hair color or any other information representative of the state(s) of a subject's hair.

Contrary to the allegation in the final Office Action at page 13, Applicant has not admitted that Marapane purportedly discloses steps performed in any order relative to one another. To clarify, Applicant acknowledged that SOME of the steps of Marapane are disclosed as capable of being performed in any order. In particular, Marapane discloses the possibility of rearranging only steps 120-170 (not 180). (Paragraphs [0031] and [0033].) Therefore, in any embodiment consistent with Marapane's disclosure, step 170 would occur before step 180.

For at least the foregoing reasons, Applicant respectfully submits that Marapane does not disclose all the claimed subject matter of independent claims 1 and 74 and that, therefore, the § 102(e) rejection should be withdrawn.

REJECTION UNDER SECTION 103(a)

The § 103(a) rejection of claims 7, 9, 17, 18, 82, 187, 188, 191, 193, 247, 248, 251, and 253 based on Marapane should be withdrawn because the Office Action fails to establish a *prima facie* case of obviousness with respect to these claims. Each of these claims is dependent upon either independent claim 1 or 74. Therefore, in light of the above-noted deficiencies of Marapane with respect to claims 1 and 74, Marapane fails to disclose all the recitations of claims 7, 9, 17, 18, 82, 187, 188, 191, 193, 247, 248, 251, and 253. Further, there is no motivation, suggestion, or teaching in Marapane or any other source to modify Marapane in a manner that would cure the deficiencies noted above with respect to independent claims 1 and 74. Additionally, these dependent claims include further limitations that distinguish from the cited art.

In Applicant's previous response, Applicant submitted arguments similar to those above with regard to the § 103(a) rejection, which has been repeated in the pending final Office Action. In response, the Examiner alleges that "Applicant's arguments fail to

comply with 37 C.F.R. 1.11(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.” Final Office Action at 13. Applicant respectfully submits that Applicant’s arguments regarding the § 103(a) rejection are more than “a general allegation that the claims define a patentable invention.” Applicant respectfully submits that Applicant’s arguments point out a lack of disclosure of the claimed subject matter in the cited art and a lack of any teaching, suggestion, or motivation to modify the cited art in the manner suggested, all of which are criteria relevant to evaluating a *prima facie* case of obviousness. Therefore, Applicant has met the burden for rebutting a *prima facie* case of obviousness by clearly showing that the Final Office Action does not provide any evidence in support of a *prima facie* case.

For at least these reasons, a *prima facie* case of obviousness has not been established with respect to claims 7, 9, 17, 18, 82, 187, 188, 191, 193, 247, 248, 251, and 253. Accordingly, Applicant respectfully submits that the § 103(a) rejection of these claims should be withdrawn.

Conclusion

For at least the foregoing reasons, Applicant respectfully submits that each of independent claims 1 and 74 is allowable. In addition, each of claims 2-27, 75-98, 179-198, and 239-258 ultimately depends from one of these allowable independent claims and, therefore, should be allowable for the same reasons that the respective claim from which it depends is allowable.

The Office Action contains characterizations and conclusions regarding the related art and Applicant’s claims with which Applicant does not necessarily agree.

Unless expressly noted otherwise, Applicant declines to subscribe to any such characterizations and conclusions.

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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